



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,752	10/16/1999	PETER AR-FU LAM	ESY2A	1738
7590 09/07/2006				
PETER AR-FU LAM 20104 WAYNE AVENUE TORRANCE, CA 90503		EXAMINER ARMSTRONG, ANGELA A		
		ART UNIT 2626		PAPER NUMBER

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/419,752

Applicant(s)

LAM, PETER AR-FU

Examiner

Angela A. Armstrong

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 86-176 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 86-176 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 86-176 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claims 86-176 define non-statutory processes because they merely manipulate an abstract idea (data tables) without a claimed limitation to a practical application. The disclosed invention has a practical application in the technological arts; however, the claimed process, a series of steps to be performed on a computer, simply manipulates an abstract idea without a claimed limitation to a practical application and does not have any post or pre- computer process activity.

A review of application 09/419,752 shows the disclosed invention thereof to be a method for programming a computing device. This is a practical application within the technological arts. However, it does not disclose specific hardware, specific software, or a combination thereof for performing the claimed functions. The claims, each taken as a whole, are directed to an abstract idea that is not applied to or limited by other physical elements or process steps.

Arrhythmia Research Technology, Inc v. Corazonix Corp., 958 F.2d 1053, 22 USPQ 2d 1033 (Fed. Cir. 1992). In the instant application the disclosure is directed to any and every structure for carrying out the claimed functions, and not solely to specific structure for performing the claimed functions.

The claims, each taken as a whole, are directed to an abstract idea that is not applied to or limited by other physical elements or process steps. *Arrhythmia Research Technology, Inc v. Corazonix Corp.*, 958 F.2d 1053, 22 USPQ 2d 1033 (Fed. Cir. 1992).

In the instant application the disclosure is directed to any and every structure for carrying out the claimed functions, and not solely to specific structure for performing the claimed functions. Claims 86-176, reviewed in light of the specification, simply recite a sequence of steps to execute one or more events.

Claims 86 and 170 are written in means-plus-function format, and for the purpose of this rejection are being treated as though they were method claims. The courts have held that such treatment is acceptable:

"If the functionally-defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions, the apparatus claim is an attempt to exalt form over substance since the claim is really to the method or series of functions itself. In computer-related inventions, the recited means often perform the functions of "number crunching" (solving mathematical algorithms and making calculations). In such cases the burden must be placed on the applicant to demonstrate that the claim is truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions."

If this burden has not been discharged, the apparatus will be treated as if it were drawn to the method or process, which encompasses all of the claimed "means." See *In re Abele* 214 USPQ 682, 688 (CCPA 1982); *Ex parte Akamatsu*, 22 USPQ 2d 1915, 1920; and *Ex parte Lappet*, 23 USPQ 2d 1340, 1344.

The specification does not disclose a specific hardware, software, or a combination thereof for performing the steps of specifying user defined custom expressions, defining x qualifying instructions etc. Claim 129 recites a first and second processor and computing means respectively however, these are only general computing devices.

Taking each claim as a whole, we have field of use limitations claim 86-176. These limitations do not in any way further limit the algorithm.

As per the claims, the language "A method to program a computing device", for example, does not transform the claimed subject matter into statutory subject matter. The recital is merely a field of use or desired end use limitation.

An abstract idea is not made statutory by "attempting to limit the use of the formula to a particular technological environment." Diehr, 450 U.S. at 191,209 USPQ at 10. Thus, "field of use" or "end of use" limitations in the claim preamble are insufficient to constitute a statutory process.

This is consistent with the usual treatment of preambles as merely setting forth the environment. See Flook (the preamble, while limiting the application of the claimed method to "a process comprising the catalytic chemical conversion of hydrocarbons" did not serve to render the method statutory); Walter 618 F.2d at 769, 205 USPQ at 409 ("Although the claim preambles relate the claimed invention to the art of seismic prospecting, the claims themselves are not drawn to methods of, or apparatus for seismic prospecting")”de Castelet, 562 F.2d at 1244 n.6, 195 USPQ at 446 n.6 ("the potential for misconstruction of preamble language requires that compelling reason exist before that language may be given weight). Compare Waldbaum, 559

F.2d at 616 n.6, 194 USPQ 469 n.6 ("Portion of preambles referred for completeness of the claims and are proper limitations thereto").

The court has held that a field of use limitation cannot make a claim statutory by "attempting to limit the use of the formula to a particular technological environment. "Diamond v. Diehr 209 USPQ 1, 10 (s. CT 1981) Thus, the field of use limitation of a programming method ... fails to render the claims statutory.

The above review of the claims shows that the subject matter claimed in addition to the abstract idea is not sufficient on its own to render the claims as a whole statutory.

Further, a review of each claim as a whole fails to show the transformation or reduction of subject matter to a different state or thing.

It is readily apparent that when claims 86-176 are each taken as a whole, the claims are directed to the preemption of an abstract idea and, thus, are non-statutory.

### ***Response to Arguments***

4. Applicant's arguments filed February 3, 2003, have been fully considered but they are not persuasive. Applicant argues easy Format is not an abstract concept. In response, the Examiner argues, claims 86-176 define non-statutory processes because the limitations of the claim language merely manipulate an abstract idea (data tables) without a claimed limitation to a practical application. Applicant argues practical applications of the claimed invention are identified. The Examiner cannot concur. As claimed, the limitations of the claim language merely manipulate an abstract idea (data tables) without a claimed limitation to a practical

Art Unit: 2626

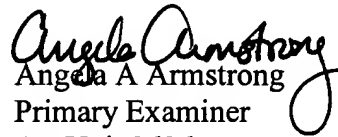
application of Easy Format programming. Applicant argues the claimed invention provides pre-computer and post process activity. The Examiner cannot concur. As claimed, the limitations of the claim language of claims 86-176 do not provide for limitations of pre-computer process activity such as the requirements of the measurement of physical objects or activities so as to provide pre-computer process activity to be transformed outside of the computer into computer data. Applicant's claims do not provide any limitations that measure any physical objects or activities to be transformed outside of the computer into computer data. Applicant argues the claimed invention provides post process activity. The Examiner cannot concur. As claimed, the claim limitations of claims 86-176 do not provide for limitations of post process activity such that a physical act is performed outside of the computer independent of and following the steps to be performed by a computer program; where those acts involve the manipulation of tangible physical objects (also not provided for in the claim limitations) and results in the object having a different physical attribute or structure (not provided for in the claim limitations).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela A. Armstrong whose telephone number is 571-272-7598. The examiner can normally be reached on Monday-Thursday 11:30-8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Angela A Armstrong  
Primary Examiner  
Art Unit 2626

AAA

September 5, 2006